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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,936	12/22/1998	Scott Miller	BAYER 6 PI	8682

7590                  05/17/2002

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza I  
Suite 1400  
2200 Clarendon Boulevard  
Arlington, VA 22201

[REDACTED] EXAMINER

KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
1621	//

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/776,936</b>	Applicant(s) <b>Miller et al</b>
	Examiner <b>Shailendra Kumar</b>	Art Unit <b>1621</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on Mar 21, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 6, 7, 10-12, and 18 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-5, 8, 9, 13-17, and 19 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5, 10
- 4)  Interview Summary (PTO-413) Paper No(s). 11
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other:

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### **DETAILED ACTION**

Claims 1-19 are pending in this application.

At the outset, as pointed out by the Counsel in paper # 9, there are four group, instead of three groups, as evidenced by the enclosed interview summary form.

1. Applicant's election with traverse of Group II, when A is phenyl and compounds are heterocyclic in Paper No. 9 and 7 is acknowledged. The traversal is on the ground(s) that all the compounds have urea functionality, and a phenyl group, thus having common link, all the claims must be examined. This is not found persuasive because A is different groups, and classification differs when A is various group, and if the compounds are non heterocyclic or heterocyclic. This will cause an undue burden on the PTO.

The requirement is still deemed proper and is therefore made FINAL.

In view of the species election, claims 6-7, 10-12 and 18 are further withdrawn from the consideration, being drawn to the subject matter which is non readable on the elected species.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 6/28/01 and 4/3/02 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56© most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has

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been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The elected species was found to be free of prior art, and the search was extended and another species was searched and art was found, as follows.

5. Claims 1-5, 9, 13-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al(US 6,143,764). \*

Instant claims are directed to symmetrical and unsymmetrical substituted diphenyl ureas, for the inhibition of RAF kinase, which has ultimate use in the treatment of tumors.

Kubo et al teach generically structurally similar compounds as claimed herein, see column 2, starting from line 50 through column 3, line 67, i.e when X is O, Q is formula (V), the reference compounds reads on the instant claimed compounds when A is phenyl, and R3-R6 can be het aryl. Also note that the method of use is similar. The difference between the reference and herein claimed compounds is that the reference has not made the specific compounds disclosed in herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful pharmaceutical composition for treating the tumors, absent evidence to the contrary.

\* US 6,143,764 has 10d(e) date of 5/6/1998, however, the corresponding PCT Pub date is 5/15/1997, for WO9717389. Since the WO Patent is about 500 pages, the US Patent was taken as reference.

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The elected species is free of prior art. The subject matter within the scope of the elected species would be allowed, subsequent to applicants' amendment to the claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703) 308-4519. The examiner can normally be reached on Monday to Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

S.Kumar

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